

REMARKS

Claims 4, 5 and 9 through 18 are pending in this Application. Claims 11 and 16 have been amended, claim 8 cancelled and new claim 18 added. Care has been exercised to avoid the introduction of new matter. Indeed, the present Amendment does not generate any new matter issue or any new issue for that matter, because the “dispersion compensating optical fiber” limitation added to claim 16 was already in claim 17 considered by the Examiner, and the limitations of claim 8 have been incorporated into claim 16 and claim 8 cancelled. In addition, in response to the Examiner's rejection of claim 11 based upon an asserted improper Markush grouping, one of the embodiments has been deleted from claim 11 and presented in new claim 18. Clearly, the present Amendment does not generate any new matter issue or any new issue. Accordingly, entry of the present Amendment and Remarks, and favorable consideration, are respectfully solicited pursuant to the provisions of 37 C.F.R. §1.116.

Priority

The Examiner requested evidence of priority that the international Application was co-pending with the U.S. National Application to obtain the benefit thereof pursuant to 35 U.S.C. §120. In response, Applicants submit herewith as Exhibit A, a copy of the front page of the International Preliminary Examination Report (English version) for the parent PCT Application (PCT/JP99/06046), bearing a priority date of October 29, 1998. Since an international preliminary examination had been requested within 19 months from the priority date, the term for entering the U.S. National Phase was extended to 30 months from the priority date. Moreover, the time limit of April 29, 2001, which corresponds to 30 months from the priority date, fell on Sunday and, hence, the present U.S. National Application could be and was

filed on April 30, 2001 (Monday). Accordingly, this Application was filed within the effective term, since it was filed on April 30, 2001, and, hence, is entitled to claim the benefit of the international application pursuant to 35 U.S.C. §120.

Claim 11 was rejected under the second paragraph of 35 U.S.C. §112.

In the statement of the rejection, the Examiner questioned the intended groupings. This rejection is traversed.

In response, the alternative embodiment encompassed by claim 11 with respect to the use of a flame has been deleted and now appears in new claim 18 with appropriate Markush terminology. Hence, in response to the Examiner's comments, claim 11 is confined to only one of the previously claimed embodiments, while the other embodiment appears in claim 18. Applicants submit that one having ordinary skill in the art would have no difficulty understanding the scope of claim 11 or claim 18, particularly when reasonably interpreted in light of and consistent with the written description of the specification. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993).

Applicants, therefore, submit that the imposed rejection of claim 11 under the second paragraph of 35 U.S.C. §112 is not viable and, hence, solicit withdrawal thereof.

Claims 4, 5, 8, 9, 11, 16 and 17 were rejected under 35 U.S.C. §103 for obviousness predicated upon Hiroo.

In the statement of the rejection, the Examiner concluded that one having ordinary skill in the art would have found it "... obvious to stretch and etch as much as desired/needed to get the results that one desires depending upon what starting materials one has available, and what sizes

are needed/desired during further processing - with no new or unexpected results” (ultimate paragraph on page 3 of the March 9, 2004 Office Action). This rejection is traversed.

Independent claim 16 is directed to a method of making a preform **for a dispersion compensating fiber**. No method of making a preform for a dispersion compensating fiber is disclosed or suggested by Hiroo. Hence, the above quoted expert from the Examiner's exposition of the rejection is not predicated on any factual basis. Applicants would emphasize that regardless of the source of motivation, the Court of Appeals for the Federal Circuit requires facts, as articulated in *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 63 USPQ2d 1374, 1387 (Fed. Cir. 2002):

The showing of a motivation to combine must be clear and particular and it must be supported by actual evidence.

No factual evidence has been presented. Indeed, it is not apparent wherein resides any factual evidence upon which to predicate the determination that one having ordinary skill in the art would have recognized that the **only** result effective variable impacting optical properties is scale combination. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re Yates*, 663 F.2d 1054, 211 USPQ 1149 (CCPA 1981); *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

In this respect, Applicants would stress that the preform of Hiroo is a material for obtaining a single-mode fiber or a dispersion-shifted fiber. In contradistinction to the preform formed by Hiroo, the preform formed in the claimed method is a material for obtaining a dispersion compensating fiber compensating for chromatic dispersion in a single-mode optical fiber. Not only that, claim 16 specifies a specific scale combination in the first collapsing step and with respect to the second collapsed body. These limitations cannot be derived from Hiroo.

The Examiner's statement that "It would have been obvious to have whatever sizes one desires, depending upon the specific optical properties one wants to have..." (page 4 of the March 9, 2004 Office Action, 3rd paragraph) is a mere generalization **without** the requisite **factual basis**. *Teleflex Inc. v. Ficosa North America Corp., supra; In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998)*. There is simply no apparent factual basis upon which to predicate the conclusion that the desired optical properties can be obtained solely by a scale combination. *In re Rijckaert, supra; In re Yates, supra; In re Antonie, supra*. Indeed, the desired optical properties **cannot** be obtained by modifying the scale combination only.

Specifically, the Hiroo reference is directed to a preform fabrication for suppressing a transmission loss by reducing OH-radicals. However, the claimed invention is directed to a preform fabrication for suppressing an increase in ellipticity in the fabrication process, while satisfying the optical properties desired as a **dispersion compensating fiber**. Both the object to be solved and the optical fiber to be obtained by Hiroo are **different** from those of the claimed invention. There is no factual or technological basis upon which to predicate the conclusion that the scale combination of the preform made by the claim method, which is for a **dispersion compensating fiber**, can be achieved from the Hiroo reference even **if** it is **assumed**, and assumption is not a basis for a rejection under 35 U.S.C. §102 or 35 U.S.C. §103, that one having ordinary skill in the art would have resorted to Hiroo for specific optical properties different from those of a single-mode fiber or a dispersion-shifted fiber, which would be against the teachings of Hiroo.

Based upon the foregoing, Applicants submit that a *prima facie* basis to deny patentability to the claimed invention has not been established for lack of the requisite factual basis and want of the requisite realistic motivation. Applicants, therefore, submit that the

imposed rejection of claims 4, 5, 8, 9, 11, 16 and 17 under 35 U.S.C. §103 for obviousness predicated upon Hiroo is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 10 and 15 were rejected under 35 U.S.C. §103 for obviousness predicated upon Hiroo in view of Berkey.

Claims 12 through 14 were rejected under 35 U.S.C. §103 for obviousness predicated upon Hiroo in view of Kyoto.

These rejections under 35 U.S.C. §103 of claims 10 and 15 and 12 through 14 are traversed. Specifically, claims 10 and 12 through 15 depend ultimately from independent claim 16. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 16 under 35 U.S.C. §103 for obviousness predicated upon Hiroo. The additional references to Berkey and Kyoto do not cure the argued deficiencies of Hiroo. Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would **not** result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claims 10 and 15 under 35 U.S.C. §103 for obviousness predicated upon Hiroo in view of Berkey, and the imposed rejection of claims 12 through 14 under 35 U.S.C. §103 for obviousness predicated upon Hiroo in view of Kyoto, are not factually or legally viable and, hence, solicit withdrawal thereof.

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It should, therefore, be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink, appearing to read 'A. J. Steiner', is written over the printed name.

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47
Translation

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference SEI 99-44 PCT	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/JP99/06046	International filing date (day/month/year) 29 October 1999 (29.10.99)	Priority date (day/month/year) 29 October 1998 (29.10.98)
International Patent Classification (IPC) or national classification and IPC C03B 37/012, 37/014		
Applicant SUMITOMO ELECTRIC INDUSTRIES, LTD.		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 5 sheets, including this cover sheet.

☒ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of 2 sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

Date of submission of the demand 28 April 2000 (28.04.00)	Date of completion of this report 30 November 2000 (30.11.2000)
Name and mailing address of the IPEA/JP Facsimile No.	Authorized officer Telephone No.